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In re Application of : DECISION ON SUPPLEMENTAL
GOLLER, et al. :
Serial No.: 10/578,233 :
PCT No.: PCT/US04/36477 : RENEWED PETITION
Int. Filing Date: 03 November 2004 :
Priority Date: 03 November 2003 : UNDER 37 CFR 1.47(a)
Atty Docket No.: TEVBNP 3.3-167 :
For: SOFT STEROID COMPOSITIONS FOR :
USE IN DRY POWDER INHALERS :
:

This decision is in response to applicant's "Supplemental Renewed Petition under 37 CFR 1.47(a)" filed 05 May 2008 to accept the application without the signature of inventor Ramesh Yanamandra.

BACKGROUND

On 13 June 2007, applicant filed a petition under 37 CFR 1.47(a) to accept the application without the signatures of joint inventors Qi Li, Katherine Salas, Anayo Michael Ukeje and Ramesh Yanamandra. On 30 August 2007, a decision was mailed dismissing the petition and indicating that Petitioner had failed to provide factual proof that the nonsigning joint inventors refused to execute the application or could not be reached after diligent effort.

On 04 March 2008, Petitioner filed a renewed petition. On 02 May 2008, a decision was mailed dismissing the petition as moot with regard to previous non-signing inventors Qi Li, Katherine Salas and Anayo Michael Ukeje and dismissing the petition without prejudice with regard to inventor Ramesh Yanamandra. The decision indicated that Petitioner had failed to: (1) provide complete declarations signed by the previously non-signing inventors and (2) demonstrate that inventor Ramesh Yanamandra refused to sign the application.

DISCUSSION

This decision considers the supplemental renewed petition under 37 CFR 1.47(a).¹ The

¹ A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the nonsigning joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the nonsigning inventor, and (4) an oath or declaration by each 37

supplemental petition solely presents the declaration of Samantha Radley Patent Administrator for Norton Healthcare Limited (assignee) regarding the nonsigning inventor's refusal or unavailability to sign the application papers. Ms. Radley states that two packages were sent to the last known address for Ramesh Yanamandra and were returned to her by the Post Office with the indication that "no one called to collect them". A copy of the envelope marked undeliverable by the Post Office accompanied Ms. Radley's statement. In earlier petitions, Petitioner provided evidence of his attempts to contact the co-inventors in order to obtain contact information for the non-signing inventor Yanamandra to no avail. Petitioner conducted Internet searches to locate the non-signing inventor as well as attempted to contact him via several email addresses and two postal mailing addresses. Petitioner has now demonstrated that *bona fide* attempts were made to present the non-signing inventor with the application papers, which were unsuccessful. The actions taken by petitioner are sufficient to demonstrate that a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/578,233 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and that Mr. Yanamandra refuses or is unavailable to sign the application papers.

However, with regard to the required declaration (Item 4), applicant did not provide complete declarations of the joint inventors. As explained in the decision mailed on 02 May 2008², the multi-page declaration executed by previously nonsigning inventors Qi Li, Katherine Salas and Anayo Michael Ukeje is unacceptable as filed. The requirements of 37 CFR 1.497 (a) and (b) have not been met. This requirement is still outstanding.

In light of the above, Item (4) above is not yet satisfied and thus, it is inappropriate to grant applicant's petition under 37 CFR 1.47(a) at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop

CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

² "The declaration, as filed, is unacceptable. The declaration is a four page declaration but is comprised of eight pages: one Page 1, and two Page 2s, three Page 3s and two Page 4s. The pages are executed by different inventors. The declaration appears to be a composite declaration created from the combination of separately executed declarations. It appears that either the attorney pieced together separate complete declarations into one composite declaration or that the inventors were presented with an incomplete declaration. Thus, the declaration is not properly executed. While it is acceptable for applicants to execute separate copies of the declaration, *the entire declaration, as executed by the inventor, must be submitted*. "Where individual declarations are executed, they must be submitted as individual declaration rather than combined into one declaration." *See* MPEP 201.03. The declaration is unacceptable as filed as the requirements of 37 CFR 1.497 (a) and (b) have not been met."

PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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